

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

BRKP:012US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on filed electronically on October 2, 2009

Signature

Typed or printed name MICHAEL R. KRAWZSENEK

Application Number

10/568,303

Filed

October 4, 2006

First Named Inventor

Mario Leclerc

Art Unit

1626

Examiner

Shawquia Young

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

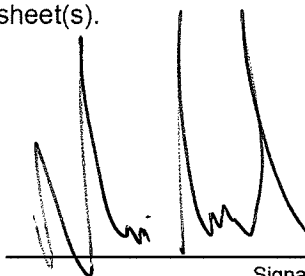
☒

attorney or agent of record.

Registration number 51,898☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

MICHAEL R. KRAWZSENEK

Typed or printed name

(512) 536-3020

Telephone number

October 2, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

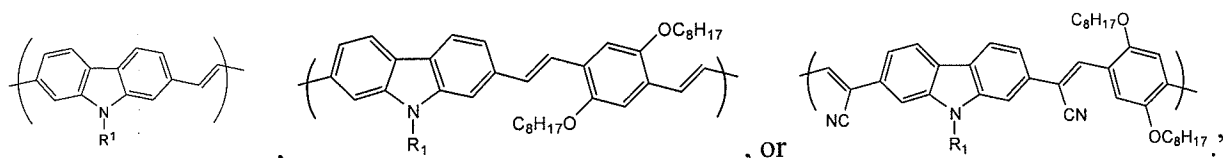
This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. Applicant's Claimed Invention

Claim 75 of the present application concerns "...a homopolymer comprising repeating monomers consisting of the following structure:



II. The New Matter Rejection Should Be Withdrawn

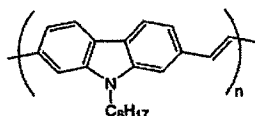
In response to the previous Office Action, Applicant amended claim 75 to include the recitation of "wherein the polymer is a homopolymer comprising repeating monomers consisting of the following structure." According to the Examiner, this amendment constitutes "new matter." In support of this rejection, the Examiner states that "[t]he original specification does not disclose homopolymers which comprise repeating monomers selected from the structures in claim 75." The Examiner also cites to the definition of polymer provided at paragraph [0057] of Applicant's specification as further support of this rejection.

Applicant disagrees with both of these points. The following provides detailed explanations confirming Applicant had possession of the homopolymers in claim 75 at the time the application was filed. See MPEP § 2163(II)(A)(3)(a).

Each aspect of amended claim 75 is *explicitly* provided in the specification except for a literal reference to the term "homopolymer." A skilled artisan, however, would clearly understand that Applicant was in possession of the claimed homopolymers at the time the application was filed. See *Martin v. Johnson*, 454 F.2d 746, 751 (CCPA 1972) (stating "the description need not be in *ipsis verbis* [i.e., 'in the same words'] to be sufficient").

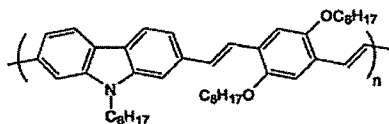
For instance, the polymers described at paragraphs [0028]-[0033] of the specification have repeating identical monomeric units and are therefore homopolymers by definition. The following passages from the specification illustrate this:

[0028] In a first particular embodiment, the present invention relates to a 2,7-carbazolenevinylene-based polymer having the formula:



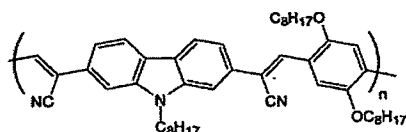
[0029] wherein " n " is an integer ranging from 5 to 100.

[0030] In a second particular embodiment, the present invention relates to a 2,7-carbazolenevinylene-based polymer having the formula:



[0031] wherein " n " is an integer ranging from 5 to 100.

[0032] In a third particular embodiment, the present invention relates to a 2,7-carbazolenevinylene-based polymer having the formula:



[0033] wherein " n " is an integer ranging from 5 to 100.

The above homopolymers fall within the scope of claim 75. *See also* Figure 4.

Additionally, Example 7 of the specification provides a non-limiting synthesis of the homopolymer illustrated in paragraph [0028] of the specification. Applicant respectfully notes that the only monomer in the reaction medium in Example 7 is compound 12, which is the

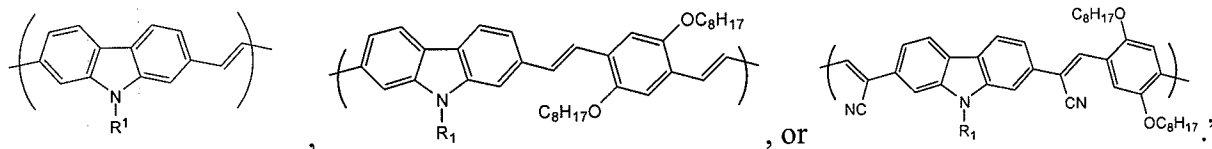
monomeric unit of the homopolymer identified in paragraph [0028] (*i.e.*, Poly(N-(2-ethylhexyl)-2,7-carbazolenevinylene) (PCV)). Examples 8-9 of the specification provide support for the homopolymer identified in paragraph [0030]. Example 10 of the specification provides support for the homopolymer identified in paragraph [0032]. In addition to the specification, claims 79, 82, 85, and 103-105 illustrate graphically such homopolymers, with the only distinction being that that R¹ remains generic in claims 75 and 103-105. ***Polymerization of only one monomer necessarily results in a homopolymer.***

Further, the Examiner's use of the specification's definition of "polymer" to support her position actually support's Applicant's position. In particular, and as correctly noted by the Examiner, the definition of polymer at paragraph [0057] of the specification says that the polymers "may" comprise different monomers. "May" clearly indicates this an optional embodiment, thus contemplating that the polymers may also ***not*** comprise different monomers. Thus, of the two choices – homo- or heteropolymers – the specification ***clearly contemplates both***. Further, and as already explained, the specification and corresponding examples provide specific support for polymers that have repeating monomeric units, which are necessarily homopolymers.

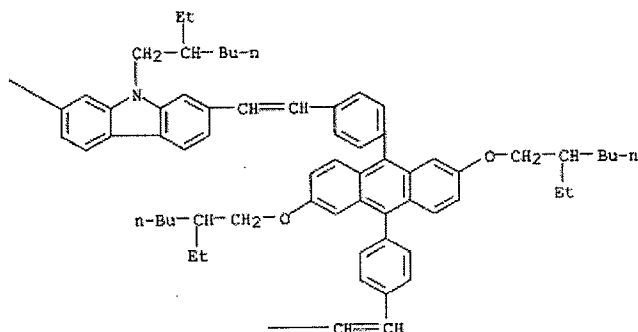
In sum, science and common sense would inevitable lead a person of ordinary skill in the art to conclude that Applicant had possession of the claimed homopolymers at least by the time that the application was filed. Applicant requests that the new matter rejection be withdrawn for at least the above-stated reasons.

III. The Anticipation Rejection Should Be Withdrawn

Claims 75-78 are rejected under 35 U.S.C. § 102(b) as being anticipated by Chen *et al.* Applicant disagrees. As noted in Section A above, claim 75 concerns "...homopolymer comprising repeating monomers consisting of the following structure:



By comparison, Chen *et al.* discloses a polymer having the following monomeric unit:



A simply visual comparison of the monomeric units claimed by Applicant and the one disclosed in Chen *et al.* confirms that the Chen *et al.* structure is quite distinct—*i.e.*, it does not disclose Applicant's monomer "as arranged in the claim." See *Richardson v. Suzuki Motor Co.*, 886 F.2d 1226, 1236 (Fed. Cir. 1989) (explaining that an anticipatory reference must disclose every aspect of the claimed invention "as arranged in the claim."). That is, it does not clearly and unequivocally disclose the claimed compound. Indeed, the only way that the Examiner can show that the Chen *et al.* compound discloses the monomers in claim 75 is to (1) segment the compound into two compounds and (2) ignore one of the compounds (in particular, the anthracene portion). The problem with this approach is two-fold. First, Chen *et al.* does not state that its compound is to be segmented into two compounds. Second, such an approach violates the basic tenets of a valid anticipation rejection. See, *e.g.*, *In re Arkley*, 455 F.2d 586, 587 (CCPA) (explaining that an anticipatory reference must "clearly and unequivocally disclose the claimed compound or direct those skill in the art to the compound without any need for picking, choosing, and combining various disclosures....").

Applicant request's that the current anticipation rejection be withdrawn in view of the above-stated reasons.

IV. Written Description and Indefiniteness Rejections

Claims 75-85 and 103-105 are rejected under 35 U.S.C. § 112, first and second paragraphs, for allegedly lacking written description and being indefinite. Applicant disagrees. As argued above in Section II, claim 75 is fully supported by the specification.

As for indefiniteness, the Examiner appears to take the position that use of “comprising” in conjunction with “polymer” is inherently indefinite due to the possibility of other monomers being included in the claimed polymer. If this is the Examiner’s position, then the natural consequence would be that all claims in all patents using the term “comprising” in conjunction with a chemical structure are indefinite. Case law and the MPEP, however, confirm that this is not the case. *See* MPEP § 2173.05(t) (“A claim to a chemical compound is not indefinite merely because a structure is not presented or because a partial structure is presented.”).

In any event, the fact that the Examiner may be concerned that “the specification fails to disclose all of the various types of monomer units that could be present in the polymer” is of little consequence to the issue of indefiniteness under the present fact situation. *See* MPEP 2173.04 (explaining that “[b]readth of a claim is not to be equated with indefiniteness”). What the specification discloses is specific homopolymers that are encompassed by claim 75.

Further, the claims provide specific monomeric structures that make up the claimed homopolymers. Therefore, the scope of claim 75 is clear. *See* MPEP 2173.04 (“If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.”).

Applicant requests that the written description and indefiniteness be withdrawn for at least the above-stated reasons.